

REMARKS

Reconsideration and allowance of this application are respectfully requested. Claims 7, 13, 19, 25-26, 28, 30 and 32 are cancelled. Claims 1-6, 8-12, 14-18, 20-24, 27, 29 and 31 remain in this application and are submitted for the Examiner's reconsideration.

In the Office Action, the Examiner issued the following rejections under 35 U.S.C. § 103(a): (1) claims 1-2, 8, 14, 19, 29, and 31 were rejected as being unpatentable over Hind (U.S. Patent No. 6,635,088) in view of Davison (U.S. Patent No. 6,304,601) and Porter (U.S. Patent No. 6,163,811); (2) claims 3-4, 9-10, and 15-16 were rejected as being unpatentable over Hind in view of Davison and Porter and in further view of Examiner's Official Notice; (3) claims 5-6, 11-12, and 17-18 were rejected as being unpatentable over Hind in view of Davison and Porter as applied to claims 1, 8, and 14 and further in view of Bodin (U.S. Patent No. 6,311,223); (4) claims 20 and 33 were rejected as being unpatentable over Hind in view of Davison; (5) claims 21 and 22 were rejected as being unpatentable over Hind in view of Davison and further in view of Examiner's Official Notice; and (6) claims 23-24 were rejected as being unpatentable over Hind in view of Davison and in further view of Bodin. Applicant submits that the claims are patentably distinguishable over the cited art.

In each of the above rejections, the Examiner relies on the asserted combination of Hind and Davison in combination with other art. However, as pointed out in the August 1, 2006 Amendment, Hind teaches away from combining the two references. Hind describes compressing the size of documents or files by replacing a string with a shorter entity only when a formula based on the number of occurrences of that string, the size of the string, and the size of the replacement string indicates that it is cost effective. As Hind describes:

When the end of the string table has not been reached, Block 475 computes a formula that determines whether the fist (*sic*) exception case is met ensuring that the replacement cost of using entity substitution is less than the cost of keeping the original strings....When this formula evaluates to true, Block 475 has a positive response and control will transfer to Block 480 to complete the process of replacing the string by an entity. Otherwise, the replacement cost for using an entity is too high, so control transfers back to Block 465, skipping the replacement process for the string. (Emphasis added.)

(See col.11 ll.20-43.)

In the present Office Action, the Examiner responds by citing column 4, line 66 to column 5, line 3 of Davison which describes:

...Nevertheless, by allocating the tokens in the manner described above, the actual storage requirement is substantially reduced because many component strings which in ASCII would occupy several bytes are replaced by a single byte.

However, the relied-on section of Davison neither disputes, contradicts, nor refutes the teaching away of Hind. Rather, the cited section of Davison merely describes text compression in the same manner as described by Hind prior to Hind's teaching away from such compression when not cost effective. Specifically, Hind describes:

...According to the present invention, an entity declaration will be created for the strings that appear in a document file being compressed, replacing the strings with a shorter entity reference, thereby compressing the amount of space required for the string.

(See col.9 ll.34-38.) Namely, Hind first describes that compression reduces the amount of space required for a string and subsequently points that such compression should not be carried out when the replacement cost is too high. By contrast, Davison only describes that compression reduces the amount of storage without addressing the issue of how to determine whether

such compression is cost effective. Hence, the relied-on section of Davison simply fails to address an issue discussed by Hind and does not conflict with the teachings of Hind.

The Examiner nevertheless asserts that "In other words, the actual placement cost is not too high according to the method of Davison and would still allow for substantial benefits. As such, there is no teaching away." However, as set out above, the relied-on section of Davison is not at all concerned with determining the cost of compression. Therefore, the Examiner cannot assume that the cost of carrying out the method described by Davison is never too high simply because the determination of such cost is not discussed in the cited section of Davison.

Therefore, a person of ordinary skill in the relevant art, having the Hind and Davison references before them, would have an earlier reference (Davison) in which the cited section simply describes that compression reduces the amount of required storage and a later reference (Hind) that similarly teaches that compression reduces the amount of space required but then teaches away from such compression when it is determined to be not cost effective. Therefore, the ordinary practitioner would find an overall teaching away in the cited art.

The Examiner also contends that "Davison teaches scanning a file for a plurality of character strings and sorting the plurality of character strings in order of their appearance frequency" and refers to column 4, lines 24-54. However, claim 1, for example, calls for:

associating, for each one of the plurality of character strings, that character string with a specific one of a plurality of substitute characters or character strings such that when a respective one of the plurality of character strings has a greater appearance frequency than another one of the plurality of character strings, the specific one of the plurality of substitute characters or character

strings that is associated with the respective one of the plurality of character strings has a same or smaller number of characters than the specific one of the plurality of substitute characters or character strings that is associated with the another one of the plurality of character strings[.]

By contrast, the relied-on section of Davison only describes sorting the order of entries in a table according to their occurrence frequency. The relied on section of Davison does not disclose or suggest associating a character sting having a greater appearance frequency with a substitute string having a smaller number of characters. In fact, Davison teaches away from substituting in this manner:

...It is also feasible to identify the most frequently occurring component strings with a lesser number of bits. In practice it has been found that the additional complexity of this procedure is not matched by a worthwhile increase in compression. (Emphasis added.)

(See col.5 ll.3-7.)

It follows that the asserted combination of Hind and Davison is improper, and therefore the Examiner cannot rely on such a combination of references in rejecting claims 1 and its dependent claims. Moreover, independent claims 8, 14, 20 and their dependent claims each include similar limitations. Therefore, claims 1-6, 8-12, 14-18, 20-24, 27, 29, and 31 are patentably distinct and unobvious over the cited art.

Applicant therefore respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

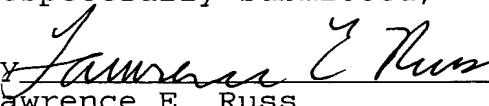
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the

Examiner telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which the Examiner might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: January 3, 2007

Respectfully submitted,

By 
Lawrence E. Russ

Registration No.: 35,342
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicant

720688_1.DOC